



200206163-1

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

James J. de Blanc

Application No: 10/646,572

Filed: August 23, 2003

For: PLANAR LAYER WITH  
OPTICAL PATH

Examiner: Rahll, Jerry T.

Art Unit: 2874

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on

December 31, 2005

Date of Deposit

*William D. Davis*

William D. Davis

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT**

In response to the Restriction Requirement dated NOVEMBER 1, 2005, applicant provisionally elects Group I including claims 1-27 with traverse. The Examiner has also imposed a species-election requirement, requiring applicants to elect either claims 1-23 or claims 24-27. Applicant provisionally elects claims 1-23.

**Distinction of Groups I and II**

The Examiner has divided claims 1-49 into 2 groups as follows:

Group I: 1-27 drawn to a method of forming an optical path

Group II: 28-49 drawn to an optical communication apparatus

The Examiner has reasoned:

Inventions I and II are related as process of making and process made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP §806.05(f)). *In the instant case the process of Invention I can make other devices such as various optical path device configurations for use in optical systems and the product of Invention II can be made from various methods, including etching, milling, irradiation and material deposition.*

Applicant respectfully submits that the Examiner has improperly restricted the claims. The Examiner is not free to ignore the language of the claims when imposing the restriction requirement. In particular, the Examiner must show either (1) that the process as claimed can be used to make other and different products (i.e., *products different from those claimed in the apparatus claims*); or (2) that the product as claimed can be made by another and materially different process (i.e., *a process different from that claimed in the process claims*). (see, MPEP § 806.05(f))

With respect to the Examiner's first point, applicant respectfully submits that *the Examiner has not shown, for example, that the process of Invention I (e.g., Group I, claim 1) can be used to make a product that is a materially different product from Invention II (e.g., Group II, claim 28).*

Claims 1 and 28 include the language:

1. A method of forming an optical communication path, comprising:
  - a) *creating a channel within a planar layer; and*
  - b) *forming at least a portion of an optical path within the channel.*

(Group I: Claim 1)(*emphasis added*)

28. An optical communication apparatus comprising:  
*a planar layer; and  
an optical path at least a portion of which is formed within the planar layer.*

(Group II: Claim 28)(*emphasis added*)

Thus, *the Examiner has not provided any example of a product made by the process defined by claim 1 that is different from the product claimed in claim 28.*

With respect to the Examiner's second point, applicant agrees that Invention II (e.g., Group II, claim 28) could be fabricated by any number of processes. However, the Examiner must show that the product of claim 28 (Group II) can be made by a process *other than the process claimed*, for example, in claim 1 (Group I).

Applicant notes that neither claim 1 (Group I) nor claim 28 (Group II) excludes any specific forms of fabrication. The fabrication techniques provided by the Examiner are irrelevant to either claim 1 or claim 28 since

these claims neither limit nor exclude any of the identified techniques. The fabrication techniques identified by the Examiner are thus not points of distinction between claims 1 and 28. *The Examiner has not shown that the product of Invention II (e.g., claim 28) can be made by a process other than the process of Invention I (e.g., claim 1).*

Applicant respectfully requests the Examiner to either withdraw the restriction requirement distinguishing Groups I and II or to alternatively provide reasons supported by the claim language for differentiating the claims from each other.

The species election is contingent upon the restriction requirement. If the restriction requirement is withdrawn, the species requirement and applicant's provisional elections are likewise withdrawn.

#### **Other Comments**

The Examiner indicated that a telephone call was made on October 29, 2005 to request an oral election, but did not result in an election being made. This statement is ambiguous as to who was contacted and whether contact was actually made. For the record, the undersigned was not party to any telephone conference with the Examiner, nor did the Examiner leave any voicemail message that would enable the undersigned to be aware that the Examiner was attempting to resolve any matters by telephone conference.

#### **Conclusion**

If there are any issues that can be resolved by telephone conference, the Examiner is respectfully requested to contact the undersigned at (512) 858-9910.

Respectfully submitted,

Date December 31, 2005

William D. Davis

William D. Davis  
Reg No. 38,428